



IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

FILED

JAN - 3 2001

U. S. DISTRICT COURT
EASTERN DISTRICT OF MO
ST. LOUIS

U.S. RING BINDER HOLDINGS, L.P.,
a Delaware limited partnership,

Plaintiff,

v.

Case No.

WORLD WIDE STATIONERY
MANUFACTURING COMPANY LIMITED,
a Hong Kong corporation,

Defendant.

4:01CV00011TCM

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff, U.S. Ring Binder Holdings, L.P. (hereafter "U.S. Ring Binder"), by and through its attorneys, seeks a Declaratory Judgment that certain fasteners for ring binders, and ring binders made using said fasteners, made and to be offered for sale by U.S. Ring Binder do not and have not infringed patent rights of Defendant, World Wide Stationery Manufacturing Company Limited. In support of this action, U.S. Ring Binder alleges:

1. U.S. Ring Binder is a Delaware limited partnership with a principal place of business at 6800 Arsenal Street, St. Louis, Missouri.

2. Defendant World Wide Stationery Manufacturing Company Limited (hereafter "World Wide Stationery") is a foreign corporation with a principal place of business in Hong Kong, Republic of China. World Wide Stationery is engaged in the business of making and selling fasteners for ring binders and ring binders throughout the United States, including the Eastern District of Missouri.

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3. This is a Complaint for Declaratory Judgment under 28 U.S.C. §§2201 and 2202, in respect to an actual controversy of which this Court has jurisdiction under the Patent Laws of the United States (35 U.S.C. §1 *et seq*) and 28 U.S.C. §1338(a) and 28 U.S.C. §1332. Venue is appropriate under 28 U.S.C. §1391(b) and (c).

4. U.S. Ring Binder itself has for a number of years made and sold fasteners for ring binders and ring binders in the United States.

5. On or about December 28, 2000, Mr. Keith A. Rabenberg, an attorney for World Wide Stationery acting in World Wide Stationery's behalf, mailed a letter to Mr. William B. Cunningham, an attorney for U.S. Ring Binder, regarding the "crown fastener" ring metals made by, and to be sold by, U.S. Ring Binder. A copy of that December 28, 2000, letter is attached hereto as Exhibit A. The said Exhibit A letter alleged that World Wide Stationery owns U.S. Patent No. 5,842,807 (hereafter the "'807 Patent") and that U.S. Ring Binder's crown fastener infringes the '807 Patent. The said Exhibit A letter further demanded that U.S. Ring Binder immediately cease and desist from any further production, marketing, importing, distribution, sale, or use of the crown fastener ring metals in the United States. A copy of the '807 Patent is attached hereto as Exhibits B.

6. The crown fastener accused by World Wide Stationery does not, and would not, infringe the claims of the '807 Patent.

7. The claims of the '807 Patent, which World Wide Stationery has alleged would be infringed by U.S. Ring Binder through making and selling the accused crown fastener, are invalid, void and unenforceable for one or more of the following reasons:

- (a) the said claims are invalid under 35 U.S.C. § 101;
- (b) the said claims are invalid under 35 U.S.C. § 102;

(c) the alleged invention on said claims would have been obvious to a person having ordinary skill in the art in view of the prior art at the time of the alleged invention and was not patentable under 35 U.S.C. §103;

(d) the patent does not comply with the requirements of 35 U.S. C. §112; and

(e) the named inventor is not the inventor under Title 35 of the United States Code, including but not limited to 35 U.S.C. § 115.

8. World Wide Stationery's charges of infringement of the '807 Patent and the demands for U.S. Ring Binder to cease and desist producing, marketing, importing, distributing, selling or using the crown fasteners that World Wide Stationery has alleged to infringe, constitute a grave and wrongful interference with the business of U.S. Ring Binder in this District in violation of the Patent Laws of the United States. Further, the foregoing threats and actions taken by World Wide Stationery create an actual controversy within the scope of 28 U.S.C. §2201.

WHEREFORE, U.S. Ring Binder prays that this Court enter judgment:

I. Declaring the '807 patent to be invalid, unenforceable, void and noninfringed by U.S. Ring Binder.

II. That U.S. Ring Binder be awarded its damages including attorneys fees for World Wide Stationery's wrongful assertion of the '807 patent.

III. Defendant World Wide Stationery be taxed with the full cost of the suit and full amount of U.S. Ring Binder's attorneys fees expended for defending itself against World Wide Stationery's claims of patent infringement.

IV. The damages awarded to U.S. Ring Binder be trebled.

V. The Court grant U.S. Ring Binder any such other relief as the Court deems just and proper.

U.S. RING BINDER HOLDINGS, L.P.

By: 

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AND RELATED MATTERS

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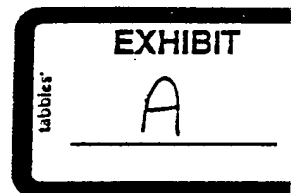
STUART N. SENNIGER
(1921-1997)

December 28, 2000

Via telecopy to 314-991-2178
and by regular mail

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Re: "Crown fastener" ring metal being marketed by U. S. Ring Binder Corporation

Dear Bill:

Our client, World Wide Stationery Manufacturing Co., Ltd., has come to understand that your client U.S. Ring Binder Corporation has begun actively marketing the "crown fastener" ring metals in the United States and, if it has not done so already, is now prepared to deliver them to customers who may purchase them. It is our understanding that the crown fastener being marketed by U.S. Ring is of the same design as the 21 samples you provided to me during the course of the present lawsuit (on October 20, I believe).

World Wide has conducted tests on the 20 samples of the crown fastener that I received from you and was able to send to China, and World Wide's test results indicate that the small prongs (or "teeth," as you have referred to them) on the crown do not have any significant securing effect. You have informed me that your client conducted some testing as well, and that testing suggested the small prongs did have some effect. I requested additional samples so that more extensive testing could be conducted, but you declined to provide them. Based on our client's testing, and based on our client's review of your client's test results, we are not convinced that the small prongs serve any functional purpose.

We have also considered, and disagree with, the arguments you raised in your September 20 letter to me in support of your position that the crown fastener does not infringe World Wide's patent no. 5,842,807. Your letter focuses on two phrases in claim 1 of the '807 patent: (1) "at least one integral securing means for securing said ring binder to said base member," and

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Mr. William B. Cunningham

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(2) "a plurality of securing elements for securing said ring binder to the base member, at least 75% of said elements extending away from a longitudinal axis of the engagement portion."

With respect to the first of these phrases, we disagree with your "means plus function" argument. Your argument requires an interpretation of the patent that, in essence, requires the incorporation of additional unwritten limitations into claim 1. Also, please note that we have recently applied for reissue of the '807 patent with the objective of adding claims to the patent that we believe will clearly be infringed by the crown fastener. Therefore, to the extent your argument is valid (with which we disagree), we assume that the basis for your argument will be eliminated upon reissue of the patent.

With respect to the "75%" limitation, there are at least three reasons why we do not agree that it provides you with a viable defense to infringement. First, as noted above, it appears that the small prongs do not have any securing effect. Because claim 1 of the patent refers to "securing elements," not to "teeth" or "prongs," and because only the large prongs have a securing function, then only the large prongs are "securing elements," and 100% of those securing elements extend away from the center of the crown. Second, even if the small prongs could be considered "securing elements," their securing function clearly represents much less than 25% of the securing function of all the prongs together. Third, as noted above, we anticipate that the reissued patent will include additional claims that will eliminate any doubt that the patent is infringed by the crown fastener.

Accordingly, it is World Wide's position that U.S. Ring's crown fastener does infringe the '807 patent, and the infringement will be even more clear upon reissue of the patent. We must, therefore, demand that your client immediately cease and desist from any further production, marketing, importing, distribution, sale, or use of the crown fastener ring metals in the United States. Please provide us your written assurance that U.S. Ring Binder will comply with this demand.

Sincerely,



Keith A. Rabenberg

KAR